

REMARKS

Drawings

In the last response, Applicant responded to the Examiner's objection to the drawings. In the present action, no mention is made of the drawings, leading Applicant to believe that the objection is withdrawn. However, Applicant requests explicit notice that the drawing objection has been withdrawn in the next communication from the Office.

Incorrect Listing of Claims

The Examiner has indicated in both the summary and in the text of the Action that claims 1-7, 10-21, 24-35 and 39-46 are pending in this application. This is incorrect. Applicant notes that claim 36 remains pending in the application. Notice of the correct status of claim 36 by the Examiner is respectfully requested.

Claim Rejections

Applicant submits that the Examiner has procedurally failed to establish a *prima facie* case for rejection of claim 14 and the finality of this Action should therefore be withdrawn. Specifically, Applicant submits that the Examiner has again failed to address limitations present in claim 14, necessarily defeating the establishment of a *prima facie* case for rejection of this claim on procedural grounds if nothing else. In the earlier response, Applicant pointed out that claim 14 depends from claim 13, not directly from claim 1. However, in the rejection of claim 14, the Examiner again ignores the limitations present in claim 14 due to its dependence from claim 13. As such, it is

impossible for the Examiner to have presented a *prima facie* case with respect to claim 14. Accordingly, Applicant submits that claim 14 has never been properly rejected, regardless of any differences of opinion about the teachings of the cited art. Due to this fundamental procedural error, Applicant requests that the finality of this Action be withdrawn.

Applicant notes a similar procedural flaw with respect to the rejection of claim 28, which depends from claim 27, not claim 15. The Examiner again ignores the limitations present in claim 28 due to its dependence from claim 27, despite this point being specifically made in the last response. As such, it is impossible for the Examiner to have presented a *prima facie* case with respect to claim 28. Accordingly, Applicant submits that claim 28 has never been properly rejected, regardless of any differences of opinion about the teachings of the cited art. Due to this fundamental procedural error, Applicant requests that the finality of this Action be withdrawn.

Turning now to more substantive issues, Applicant has previously noted that independent claim 1 is directed to a communication terminal that comprises, *inter alia*, "a receiver ...; a comparator...; a display; and a controller controlling said display to display a video image extracted from said video signals based on the comparison of said received audio signals." The Examiner responds to this argument by pointing to "fig. 9; col. 3, lines 26-27; col. 10, line 17 through col. 11, line 8" of Kohda. However, this response by the Examiner is in error for at least two reasons.

First, while the Examiner responds to Applicant's argument by pointing to Kohda Figure 9, etc., the Examiner does not appear to base the rejection of claim 1, either now

or in the past, on this newly cited information. Attention is directed to page 2 of the Action, the only place in the Action where the Examiner discusses the rejection of claim 1. Absolutely no mention is made about Figure 9, or col. 3, lines 26-27; or col. 10, line 17 through col. 11, line 8. Instead, the only detailed explanation of the rejection of claim 1 merely repeats what appears to be the exact same language used to reject the claim in an earlier action. Accordingly, the only possible legal conclusion is that the Examiner has not changed the legal basis of the rejection in any way whatsoever, and therefore is not relying in any way on the Figure 9, etc. information for the rejection of claim 1. As the Examiner appears to admit that the relied on passages of Kohda -- specifically Figures 4-5; col. 6, lines 44-46; col. 7, lines 3-38; and col. 11, lines 9-31 -- do not show the communication terminal having a display, Applicant submits that the Examiner's rejection is procedurally flawed. In short, the Examiner still fails to present a *prima facie* case of anticipation in a manner required by the MPEP. If the Examiner wishes to rely on the Figure 9, etc. information, the Examiner is required under the MPEP and relevant rules to plainly state the reason for the rejection of claim 1 pointing to all the passages relied on when discussing the rejection. Sweeping generalizations and citations untied to any rejection are improper and fail to establish a legally proper rejection. Further, if the Examiner is in fact relying on the brand new passages of Kohda mentioned for the first time in this action for the rejection of claim 1 or any other claim, then Applicant submits that this is a **new grounds of rejection**. Accordingly, if this is the case, then Applicant submits that making the rejection final at this time is improper, and **the finality must be withdrawn**.

Second, even assuming *arguendo* that Kohda's work station of Figure 9 is a *communication terminal*, the Kohda work station of Figure 9 simply does not meet the claim limitations of claim 1. Where in any of the elements labeled 90-98 is there any sort of "comparator comparing said received audio signals from said remote participants" and "controller controlling said display to display a video image extracted from said video signals based on the comparison of said received audio signals," both as required by claim 1? There simply are no such elements shown or suggested to be in the relevant work station in Figure 9 or any of the corresponding text. Absent such elements, Kohda's work station of Figure 9 simply cannot anticipate the subject matter of claim 1.

Further, it is interesting to note that the Examiner states that "Kohda does teach an image distributing unit employing an image display system with display." While Applicant agrees, *arguendo* (for purposes of this argument), that Kohda's image distributing unit 20 apparently sends/receives audiovisual signals from various terminals 90, the Kohda image distributing unit 20 is a centralized unit, separate and distinct from the various terminals 90. Thus, even if the entirety of Kohda's system has the claimed elements, there simply is no showing in Kohda that a communication terminal has all the elements, as required by claim 1. Applicant submits that one of ordinary skill in the art would not consider Kohda's image distributing unit 20 to be part of a "communication terminal." If anything, Kohda's image distributing unit 20 is a "host" not a "terminal." This point appears to be undisputed by the Examiner, and the Examiner has not pointed to any teaching in Kohda or anywhere that suggests the contrary. As such, Applicant submits that Kohda fails to teach the subject matter claimed in independent claim 1.

If the rejection of claim 1 is maintained, the Examiner is specifically requested to **identify** the structure corresponding to **each claimed element that the Examiner asserts is present in Kohda using Kohda's reference numbers**. Also, the Examiner is specifically requested to **identify exactly what components in Kohda allegedly make up the required communication terminal**. These requests are done with specific reference to MPEP §706.07 which requires "The examiner should never lose sight of the fact that in every case the Applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Because a central issue in the present rejection is whether Kohda shows a communication terminal with all the required elements, Applicant submits that the detailed identification is necessary in order to clarify the ambiguity present in the Examiner's current explanation of the grounds for rejection of claim 1.

Regarding claim 3's issue of "wherein said comparator selects as said active participant said remote participant from which the strongest audio signal is received," the Examiner rather strangely asserts that this limitation is not present in claim 3. Plainly, the express text of the limitation added by claim 3 as originally filed requires that the comparator examine the incoming audio signals to identify which one has the strongest audio signal. However, because Applicant wishes to narrow any issues for appeal, Applicant is amending claim 3 to add "wherein said comparator compares said received audio signals from said remote participants to determine the strongest received audio signal, and." This amendment is fully supported by the specification as filed, see, e.g., page 2, lines 13-15. As such, this amendment does not introduce new

matter.<sup>1</sup> Further, Applicant notes that because this issue has squarely be raised earlier during the prosecution of this case, it is impossible for this amendment to raise a new issue or require a new search. On this issue, the Examiner asserts that because Kohda selects the speaking participant, Kohda necessarily selects the strongest audio signal. However this is incorrect. Kohda appears to merely flag any incoming signal that appears to include speech, and then anoints the temporally last two flagged signals as the ones to display. There is no indication anywhere in Kohda that any comparison between incoming signals is made, much less such a comparison that determines which participant to select as the active participant. Thus, whatever else Kohda may do with respect to audio signals, Kohda simply does not teach or suggest "wherein said comparator compares said received audio signals from said remote participants to determine the strongest received audio signal, and wherein said comparator selects as said active participant said remote participant from which the strongest audio signal is received based on said comparing," as required by claim 3. Accordingly, claim 3 defines patentable subject matter over the cited art, even if independent claim 1 does not.

With regard to dependent claim 5, Applicant notes that the sole rationale given by the Examiner for the rejection uses what appears to be the exact same language as in the previous rejection. Thus, the Examiner continues to admit that "Kohda does not explicitly disclose the distinguishing feature to be one wherein the controller freezes all but one of the video image of one remote participant based on the comparison of the received audio signals from the remote participants by the comparator." The Examiner

---

<sup>1</sup> Similar amendments are made in claims 14, 17, 28, 33, and 44. All of these amendments are fully supported, do not add new matter, and cannot raise new issues or require additional search.

then asserts that "Palmer teaches a communication terminal for video conferencing with remote participants wherein the controller controls the display to freeze all but one of the video image of one remote participant based on [a] user's selective comparison of the received audio signals from the remote participants." This latter statement is a gross mischaracterization of Palmer. Applicant pointed out this clear error of the Examiner's interpretation of Palmer in the last response. See pages 16-17 of the earlier response. The Examiner has failed to rebut Applicant's explanation of Palmer -- that only the sender may control the "freezing" -- in any way. Given that the Examiner's expressly relied on explanation of Palmer is clearly in error, any rejection that expressly relies on that flawed interpretation must by definition be legal error. As such, Applicant submits that the §103 rejection of claim 5 is improper and cannot stand.

Applicant notes that the Examiner implies in the Response to Arguments that Applicant is arguing against the references individually. This is incorrect. Applicant is instead acting on the express admission of the Examiner that Kohda does not teach "the controller freezes all but one of the video image of one remote participant based on the comparison of the received audio signals from the remote participants by the comparator." If Kohda does not teach this limitation by the Examiner's own admission, the only place that the Examiner could be pulling the relevant teachings is from Palmer alone. Thus, Applicant pointed out that Palmer does not make the required showing. If Kohda does not make the showing, and Palmer does not make the showing, it is impossible for the combination to make the showing.

Applicant further notes that in the Response to Arguments section, the Examiner appears to be discussing something not relied on by the Examiner to reject the claim.

Further, the Examiner completely fails to address how the sender-based control of freezing frames is in any way relevant to the recipient-based control of freezing frames claimed in claim 5. This point was specifically raised in Applicant's earlier response and stands completely un rebutted by the Examiner. Applicant submits that one of ordinary skill in the art would not attempt to graft Palmer's sender-based control of freezing frames into Kohda, nor has the Examiner addressed this point. The Examiner cannot simply cherry pick the "frozen frame" aspect out of Palmer and completely disregard Palmer's teaching that the frozen frame is for a specific purpose in a sender-control system only. As such, Applicant submits that even considering the Examiner's comments on "(c)", the Examiner has failed to put forth a legally sufficient *prima facie* case of obviousness for claim 5.

With further reference to dependent claims 6-7, 10-12, the Examiner is requested to specifically answer the following question, "Does the Examiner assert that the Kohda's show/no-show reaction to too many participants to display is 'highlighting' a video image as that term is understood by one of ordinary skill in the art?" Applicant notes that Applicant previously pointed out that "Highlighting simply does not mean 'delete others,' the process taught by Kohda," an assertion that the Examiner appears to side-step in the Action. Clarification of the Examiner's position, and some attempt by the Examiner to specifically explain how Kohda's show/no-show effect somehow falls within the meaning of "highlighting," is required in order to develop the issues properly for appeal. In this regard, the Examiner is again reminded of the mandate of MPEP §706.07 that requires the Examiner to fully develop the issues if possible *before* appeal.

With additional regard to dependent claim 7, Applicant notes that the sole rationale for the rejection given by the Examiner again appears to use the exact same language as in the previous rejection. Thus, the Examiner continues to admit that "Kohda does not explicitly disclose the highlighting feature to one wherein the controller displays the one video image in an area larger than the area in which each other video image is displayed.." The Examiner then asserts that "Palmer teaches a communication terminal for video conferencing with remote participants wherein the controller controls the display to highlight one extracted video image in an area larger than the area in which each other video image is displayed." Assuming *arguendo* that Palmer is highlighting, Applicant respectfully points out that the Examiner is apparently confusing Palmer's "highlighting and sizing" approach with the claimed "highlighting by sizing." Applicant has already pointed out that Palmer at most merely teaches that the image may be "sized" only through manual intervention of the user; there is no causal relationship between the sizing step and the incoming signals. Instead, any highlighting in Palmer is a separate and distinct function from the sizing function. In contrast, the claim language plainly requires "highlight by displaying [] in an area larger..." Thus, the claim language requires that the sizing be causally related to the highlighting (*how* the highlighting is achieved, not separate therefrom); Palmer does not teach any such causal relationship between size and highlighting.

Applicant notes that the Examiner implies that Applicant is arguing against the references individually. This is incorrect. Applicant is instead acting on the express admission of the Examiner that Kohda does not teach the relevant limitation. If Kohda does not teach this limitation by the Examiner's own admission, the only place that the

Examiner could be pulling the relevant teachings is from Palmer alone. Thus, Applicant pointed out that Palmer does not make the required showing. If Kohda does not make the showing, and Palmer does not make the showing, it is impossible for the combination to make the showing.

Applicant further notes that in the Response to Arguments section, the Examiner appears to be discussing something not relied on by the Examiner to reject the claim. Further, the Examiner completely fails to address how the recipient-user's manual control of display size, as taught by Palmer, is in any way relevant to the comparator/controller control of size claimed in claim 7. This point was specifically raised in Applicant's earlier response and stands unrebutted. Applicant submits that one of ordinary skill in the art would not attempt to graft Palmer's user-based control of size into Kohda, nor has the Examiner addressed this point. The Examiner cannot simply cherry pick the "variable size" aspect out of Palmer and completely disregard Palmer's teaching that sizing is only controlled by the user independently of any incoming signals or highlighting based on those incoming signals. As such, Applicant submits that even considering the Examiner's comments on "(e)", the Examiner has failed to put forth a legally sufficient *prima facie* case of obviousness for claim 7.

With further regard to claim 11, this claim requires "wherein said controller controls said display to highlight said one video signal by displaying alphanumeric identification..." The Examiner expressly admits that "Kohda does not [] disclose the highlighting to be in the form of displaying alphanumeric identification." Thus, the Examiner relies *solely* on Tang for this teaching. Applicant previously argued that the *combination* of Kohda and Tang did not make the necessary showings because the

express admission of the Examiner showed that Kohda did not, and then pointing out that Tang did not either. Thus, the Examiner's statements regarding "arguments against the references individually" is without merit and irrelevant. Further, Applicant notes that whatever Tang teaches about alphanumeric labels (e.g., "Trevor Morris x63097...") is in the context of always displaying such alphanumeric labels. If these labels are always displayed, how then are they "highlighting" in response to a dynamic situation? They are not. Nor would one of ordinary skill in the art look to this "always there" labeling for any insight for highlighting. Thus, even if the "always there" alphanumeric labeling approach of Tang is somehow grafted onto Kohda, the resulting system would have the "always there" alphanumeric labeling, which simply is not the claimed "highlight said one video signal by displaying alphanumeric identification." Thus, the combination of Tang and Kohda, assuming *arguendo* that such combination is proper, would not result in the invention claimed in claim 11.

With regards to the combination of Ludwig with Kohda (or some modified version of Kohda), Applicant notes that the Examiner has completely failed to address the issue raised by Applicant -- that combining Ludwig with Kohda as suggested by the Examiner would defeat a critical feature of Kohda, and is therefore improper. See pages 22-23 of the earlier response. Thus, even assuming *arguendo* that Ludwig is in the field of video conferencing, the evisceration of a key aspect of Kohda by modifying Kohda according to Ludwig as suggested by the Examiner renders the combination improper under §103. The Examiner is requested to specifically address this point in the next communication.

Regarding the landscape/portrait mode issue, Applicant submits that the Examiner is omitting an important aspect of the meaning of portrait/landscape to one of

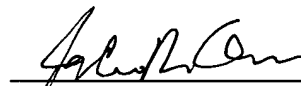
ordinary skill in the art. That is, in defining portrait/landscape modes, more than just the dimensions are relevant -- the orientation of the image in those dimensions is also relevant. One of ordinary skill in the art understands that the "up" portion of an image in portrait mode is toward the shorter dimension, and that the "up" portion of an image in landscape mode is toward the longer dimension. This meaning is part and parcel of the terms "portrait mode" and "landscape mode." Thus, even though the word "orientation" does not appear in the claim, there must be a change in orientation of the image to go from portrait mode to landscape mode, as claimed. See also the discussion of the change in portrait/landscape mode at page 11 (mentioning that the images are "turned 90 degrees" and describing the result as a "rotated orientation"). There is nothing in Kohda/Ludwig/Palmer to suggest any change in orientation of images, and certainly not in any causal relationship to the signals received from a plurality of remote participants, as required by claim 29. As such, Applicant submits that the Examiner has failed to put forth a *prima facie* case of obviousness for claim 29.

With regards to the other issues raised in the earlier response, if any, for the other independent claims, Applicant maintains these points. With particular attention to independent claim 15, Applicant notes that the arguments presented above with respect to independent claim 1 apply with arguably even greater force to claim 15, which is directed to a mobile terminal that comprises "a wireless receiver...; a comparator ...; a display; and a controller ...."

With regards to the other issues raised in the earlier response for dependent claims, Applicant maintains those points, but believes additional arguments are moot in view of the patentability of the respective independent claims.

Based on the above, Applicant submits that the Examiner's rejections of continue to suffer from essentially the same defects as pointed out in the earlier response for all claims. As such, Applicant submits that the pending claims define patentable subject matter for the reasons previously presented, and as further discussed above.

Respectfully submitted,  
COATS & BENNETT, P.L.L.C.



Dated: May 14, 2004

---

John R. Owen  
Registration No.: 42,055  
Telephone: (919) 854-1844